

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
087847,711	04/28/97	CHAU	D MK1718WWD

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MM11/0420

EXAMINER
DANG, H

ART UNIT	PAPER NUMBER
2873	<i>B</i>

DATE MAILED: 04/20/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 08/847,711	Applicant(s) Chao
Examiner HUNG DANG	Group Art Unit 2515

Responsive to communication(s) filed on _____.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-9 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-9 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Oath/Declaration

1. The declaration filed 4/28/97 is acceptable.

Title

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

3. The drawings filed on 4/28/97 are acceptable.

Information Disclosure Statement

4. The Information disclosure Statement filed on 4/28/97 has been considered.

Claims Rejection Under 35 USC - 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chao** (5,568,207).

Chao discloses auxiliary lenses for eyeglasses which comprising a primary lens frame (10), an auxiliary lens frame (20). The auxiliary lens frame (20) having two magnetic members (22) secure to the arms (21) thereof for engaging with the magnetic members (14) of the primary lens frame (10) for securing the auxiliary lens frame (20) to the primary lens frame (10).

The difference between the claimed invention and the Chao device is the location of the connection between the primary and the auxiliary lens frames. Claims 1-4 recites that the extension of the auxiliary lens frame is engaged over the stud and the legs of the primary lens frame. Although the Chao device does not teach the exact the location of the connection between the primary and the auxiliary lens frames as that claimed by Applicant, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. Additionally, the Applicant has presented no discussion in the specification which convinces the Examiner that the particular the location of the connection between the primary and the

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auxiliary lens frames is anything more than one of numerous location a person of ordinary skill in the art would find obvious for the purpose of providing support. It appears that these changes produce no functional differences and therefore would have been obvious.

Claims Rejection Under 35 USC - 103

6. Claims 5 , 6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Chao** (5,568,207) in view of **Chao** (5,737,054).

Chao '207 discloses auxiliary lenses for eyeglasses which comprising a primary lens frame (10), an auxiliary lens frame (20). The auxiliary lens frame (20) having two magnetic members (22) secure to the arms (21) thereof for engaging with the magnetic members (14) of the primary lens frame (10) for securing the auxiliary lens frame (20) to the primary lens frame (10). Chao '207 does not disclose that the bridge of the auxiliary lens frame having an arm extended over the bridge of the primary lens frame for securing the auxiliary lens frame to the primary lens frame.

Chao '054 disclose that the auxiliary lens frame having a middle bridge portion having a projection for engaging over the

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middle bridge portion of the primary lens frame and having a magnetic connector member for engaging with the connector member of the primary lens frame.

Because Chao '207 and Chao '054 are both from the same field of endeavor, the purpose of providing auxiliary lens frame which may be easily engaged on the primary lens frame as disclosed by Chao '054 would have been recognized as an art pertinent art of Chao '207.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the auxiliary lenses for eyeglasses, such as the one disclosed by Chao '207, with auxiliary lens frame having a middle bridge portion having a projection for engaging over the middle bridge portion of the primary lens frame and having a magnetic connector member for engaging with the connector member of the primary lens frame, such as disclosed by Chao '054 for the purpose of auxiliary lens frame which may be easily engaged on the primary lens frame.

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Claims Rejection Under 35 USC - 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371[®] of this title before the invention thereof by the applicant for patent.

Claim 7 is rejected under 35 U.S.C. 102(e) as being anticipated by **Chao** (5,737,054).

Chao '054 disclose that the auxiliary lens frame having a middle bridge portion having a projection for engaging over the middle bridge portion of the primary lens frame and having a magnetic connector member for engaging with the connector member of the primary lens frame.

Claims Rejection, Obviousness Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982);

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In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 08/848,129. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention in claims 1-9 of this application is substantially the same as that in claims of the '129 application. All the limitations in claims 1-9 of this application is included in the '129 application and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention in claims 1-9 of this application is substantially identical to that of claims in the '129 application. Although claims 1-9 of this application does not claimed the exact the location, shape, size and dimension of the

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connection between the primary and the auxiliary lens frames as that claimed by '129 application, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 08/847,708. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention in claims 1-9 of this application is substantially the same as that in claims of the '708 application. All the limitations in claims 1-9 of this application is included in the '708 application and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention in claims 1-9 of this application is

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substantially identical to that of claims in the '708 application. Although claims 1-9 of this application does not claimed the exact the location, shape, size and dimension of the connection between the primary and the auxiliary lens frames as that claimed by '708 application, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 08/847,707. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention in claims 1-9 of this application is substantially the same as that in claims of the '707 application. All the limitations in claims 1-9 of this application is included in the '707

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application and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention in claims 1-9 of this application is substantially identical to that of claims in the '707 application. Although claims 1-9 of this application does not claimed the exact the location, shape, size and dimension of the connection between the primary and the auxiliary lens frames as that claimed by '707 application, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 08/847,710. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention

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in claims 1-9 of this application is substantially the same as that in claims of the '710 application. All the limitations in claims 1-9 of this application is included in the '710 application and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention in claims 1-9 of this application is substantially identical to that of claims in the '710 application. Although claims 1-9 of this application does not claimed the exact the location, shape, size and dimension of the connection between the primary and the auxiliary lens frames as that claimed by '710 application, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

13. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being

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unpatentable over claims of copending Application No. 08/848,101. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention in claims 1-9 of this application is substantially the same as that in claims of the '101 application. All the limitations in claims 1-9 of this application is included in the '101 application and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention in claims 1-9 of this application is substantially identical to that of claims in the '101 application. Although claims 1-9 of this application does not claimed the exact the location, shape, size and dimension of the connection between the primary and the auxiliary lens frames as that claimed by '101 application, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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14. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 08/847,709. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention in claims 1-9 of this application is substantially the same as that in claims of the '709 application. All the limitations in claims 1-9 of this application is included in the '709 application and have the same purpose of attaching the auxiliary frame to the primary frame using the magnetic attraction. Thus, the scope of the invention in claims 1-9 of this application is substantially identical to that of claims in the '709 application. Although claims 1-9 of this application does not claimed the exact the location, shape, size and dimension of the connection between the primary and the auxiliary lens frames as that claimed by '709 application, the location, shape, size, dimension differences are considered obvious design choices and are not patentable unless unobvious or unexpected results are obtained from these changes. It appears that these changes produce no functional differences and therefore would have been obvious.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Any inquiry concerning this communication should be directed to Examiner Dang at telephone number (703) 308-0550.

4/98


HUNG DANG

PRIMARY EXAMINER

TECHNICAL CENTER 2800